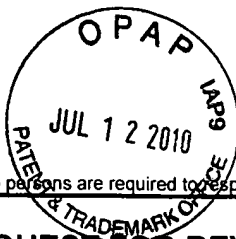


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

915-001.036

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on July 6, 2010

Signature

Typed or printed name Cathy Sturmer

Application Number

10/501,676

Filed

February 22, 2005

First Named Inventor

Terje SKAUG

Art Unit

2629

Examiner

Pegeman KARIMI

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 58,051

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Keith R. Obert

Typed or printed name

203-261-1234

Telephone number

July 6, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No: 915-001.036  
Serial No.: 10/501,676

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: **Terje Skaug**

Serial No.: **10/501,676**

Examiner: **Pegeman Karimi**

371(c) Date: **February 22, 2005**

Group Art Unit: **2629**

For: **A device for Permitting the Use of an Electronic Device as a Pointing Device**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

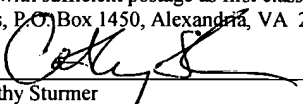
Sir:

In response to the final Office Action of March 25, 2010, please reconsider the rejections in view of the following remarks:

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to:  
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

  
Cathy Sturmer

Dated: 7.6.10

REMARKS

Claims 1-6 and 10-14 were examined by the Office, and all claims were rejected in the final Office Action of March 25, 2010. With this response, no claims are amended, added or cancelled. Applicant respectfully submits that the Office has committed clear error in rejecting the claims, because the Office has failed to show that the cited references disclose all of the limitations recited in the claims, and the Office has failed to show proper motivation to combine the cited references. Accordingly, applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following discussion.

This response is submitted along with a Notice of Appeal.

**Claim Rejections under 35 USC 103**

In section 3, on page 2 of the Office Action, claims 1-6 and 10-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Miyashita (U.S. Patent No. 6,909,906) in view of Steele (U.S. Patent No. 6,201,534), and in further view of Lee (U.S. Appl. Publ. No. 2003/0016417). Applicant respectfully submits that claim 1 is not disclosed or suggested by the cited references, alone or in combination, because the cited references fail to disclose or suggest all of the limitations recited in claim 1. Applicant respectfully submits that the cited references, alone or in combination, at least fail to disclose or suggest that the one or more pointing device components are configured to give the already existing electronic communication or player device, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device, thus enabling the already existing electronic communication or player device to act together with the external electronic screen display device, and the external electronic screen display device is other than the screen display of the already existing electronic communication or player device, as recited in claim 1.

The Office acknowledges on page 3 of the Office Action, that Miyashita does not disclose that the already existing electronic communication device or player device acts together with the external electronic screen display device, and relies upon Steele for this teaching. However, applicant respectfully submits that Steele also fails to disclose or suggest that an already existing electronic communication or player device acts together with an external electronic screen display device, where the external electronic screen display device is other than

the screen display of the already existing electronic communication or player device, as recited in claim 1. The Office asserts that video monitor (416a) of Figure 6A corresponds to the external electronic screen display device, as recited in claim 1. However, the video monitor (416a) is part of the remote control system (400a) that includes the electronic controller (414a) and the video monitor (416a). See Steele column 6, lines 41-44. Therefore, the video monitor (416a) of Steele cannot be the external electronic screen display device of claim 1, because it is at most the screen display of the already existing electronic communication or player device, since the remote controller (414a) does not include a display screen of its own. Claim 1 specifically states that the external electronic screen display device is other than the screen display of the already existing electronic communication or player device. In contrast to claim 1, in Steele, the display screen for the remote controller (414a) is that of the video monitor (416a).

Therefore, Steele would provide no motivation to provide an already existing electronic communication or player device to act together with an external electronic screen display device that is not a display screen of the already existing electronic communication or player device, since Steele only discloses one screen display. The teachings of Steele suffer from the same deficiencies recognized by the Office as Miyashita with respect to the already existing electronic communication or player device acting together with an external electronic screen display device. The Office asserts on pages 7-8 of the Office Action that since Steele teaches that a pointing device uses an external display screen, the combination of Steele and Miyashita would arrive at the claimed limitations. However, as discussed above, claim 1 requires an already existing electronic communication device or player device with a screen display, and that the external electronic screen display is other than the screen display of the already existing electronic communication or player device. Therefore, simply because the video monitor (416a) is not physically attached to the remote controller (414a) in Steele does not mean that the video monitor (416a) corresponds to the external electronic screen display device of claim 1. The Office acknowledges on page 8 of the Office Action that the remote controller (414a) does not have its own display, and merely states that because video monitor (416a) is located outside of the remote controller (414a) it corresponds to the external display screen of claim 1. However, this interpretation completely ignores the limitations of claim 1 identified above, which require a screen display and an external screen display device.

The Office appears to assert on page 9 of the Office Action that device (400a) of Steele can replace element (105) of Miyashita, or simply be added to device (102). The motivation for this modification provided by the Office appears to be that by combining the devices of Miyashita and Steele the user can use the phone and at the same time use the remote control system of Steele. See page 9 of Office Action. However, this motivation is based solely on impermissible hindsight reasoning, since the applicant specifically states on page 1, lines 28-30 of the specification that an objection of the invention is to provide an electronic aid or communication device, which can act according to its original intention, but which also has a secondary function as a pointing device. There is no motivation to combine the cited references, because the combination is based on impermissible hindsight reasoning taken directly from the specification of the present application. Accordingly, for at least these reasons, claim 1 is not disclosed or suggested by the cited references.

Furthermore, the Office acknowledges on page 4 of the Office Action that Miyashita and Steele do not mention that the pointing device is configured to operate independently of a functionality of the existing electronic communication or player device, and relies upon Lee for this teaching. The Office asserts that the functionality of the laser guiding device is separate from the functionality of the mouse. However, claim 1 requires that the already existing electronic communication or player device has, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device, thus enabling the already existing electronic communication or player device to act together with the external electronic screen display device. Merely because the laser guiding device of Lee may be separate from the functionality of the mouse in Lee does not provide one of skill in the art to modify the cited references to arrive at the limitations recited in claim 1. In particular, the projected laser beam does not enable the wireless transmission unit of Lee to act together with the computer (3) or projector (5). Instead, the laser pointing device merely acts as a pointer with respect to items on the screen (6). Lee only provides the pointer (61) that acts together with the projection screen (6) of the projector (5) in connection with the computer (3). See Lee paragraph [0028]. For at least the reasons discussed above, claim 1 is not disclosed or suggested by the cited references.

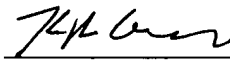
The claims rejected above, and depending from claim 1 are not disclosed or suggested by the cited references at least in view of their dependencies.

**Conclusion**

For all the foregoing reasons, it is believed that all of the claims of the application are now in condition for allowance and their passage to issue is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

Date: 6 July 2010



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